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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,027	12/11/2003	Alexander V. Lubnin	20ICT033A	7489

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LEGAL DEPARTMENT
NOVEON, INC.
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,027

Applicant(s)

LUBNIN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-37 is/are allowed.
- 6) ☒ Claim(s) 38-54 and 56-59 is/are rejected.
- 7) ☒ Claim(s) 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment of 6/16/06 has been entered. Claims 1-59 are pending.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 38-54 and 56-59 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6017998 Duan et al..

Duan et al. discloses an aqueous polyurethane coating of core shell, ipn, and graft copolymers which may be made from more than one polyurethane prepolymer (column 2, lines 10-31). The patentee is silent regarding the exact nature of the grafts, ipns, and core-shells. Since the components of the patentee fall within the scope of those of the applicant, they are expected to inherently and necessarily form the instantly claimed ice cream cone, salt and pepper, gradient, raspberry, non-uniform and other morphologies of the instantly claimed methods and compositions. The instant claims recite “comprises” and therefore do not exclude additional ingredients of the patentee. Since the prepolymers are different, they will necessarily have different hydrophilicities. See column 4, lines 36-37; column 5, lines 15-38 where the differences in dispersibilities of A and B meet the instant claims 4, 7-9 and the chain extension of the instant claims. See column 6, lines 22-43. The monols of column 7, lines 4-11 fall within the scope of the blocking agent of the instant claims. See the abstract; column 6, lines 8-22; column 7, lines 22-67; column 8, lines 1-67, particularly 10-20 and 21-38; and the remainder of the document. After the patentee’s coating is dry, the resulting film reads on the instant claims 52-54 requiring “dry form”. The instant claims are directed to compositions and articles

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per se, not the method of making them. There is no probative evidence that the compositions and products made therewith of Duan discussed above are not encompassed by the instant product claims though they are made by a different method. This rejection is maintained regarding the composition and product claims therefore particularly since the instant claims do not specify the differences between the prepolymers nor amounts relating to each different prepolymer. It is noted in polymers that each batch of polymer is necessarily a mixture of different molecules based on the concepts of average molecular weight, average functionalities, different monomer distributions throughout the molecules, etc. Thus, the products of the reference will have the required different molecules within the broad scope of the instant claims even though they were not made by the instantly claimed processes.

4. Claims 1-37 and 55 are allowable over the prior art considered because the prior art does not disclose the instantly claimed method nor provide rationale for performing the method steps as claimed.

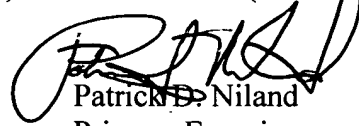
Claim 55 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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